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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,001	09/10/2003	Robert Bartek	7234	3500

7590 03/09/2005
JOHNS MANVILLE
Legal Department
10100 West Ute Avenue
Littleton, CO 80127

EXAMINER	
AHMAD, NASSER	
ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,001	BARTEK, ROBERT ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/23/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a waterproofing membrane, classified in class 428, subclass 40.1.
 - II. Claims 14-24, drawn to a method of making a waterproofing membrane, classified in class 427, subclass 138.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process such as forming in a single step of a reinforcing substrate saturated with asphalt such that its top and bottom surfaces have asphalt thereon, instead of saturating the substrate and then forming the laminate with the asphalt top and bottom layers.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Denise Lavoie on March 2, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 6-9 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sylvia (3581779).

Sylvia relates to a prefabricated asphalt based waterproofing membrane comprising an opaque pigmented polyvinyl fluoride film (PVF) adhesively adhered to a resilient waterproof backing material (abstract and figure-1). The PVF is opaque to UV light and the opacity is accomplished by incorporating pigments such as titanium dioxide into the composition (col. 2, lines 9-14). The backing material can be asphalt-saturated felt, asphalt-impregnated nonwoven fiberglass mat, etc. (col. 2, line 74 to col. 3, line 3). The material would provide for the saturated reinforced substrate having a top and a bottom surface of asphalt layers.

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The adhesive layer bonds the backing layer and the PVF directly together or the adhesive can be the primer layer with barrier properties.

Since the layer and its components of Sylvia are the same as the claimed invention, therefore it would exhibit the reflectance properties as claimed.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3,5-9 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Zanchetta (2004/0009319).

Zanchetta relates to a prefabricated asphalt-based waterproof roofing membrane (10) comprising a n asphalt saturated reinforcing substrate (page-1, paragraph-002, lines 3-9) having a top asphaltic layer (30, a reinforcing carrier (2), a bottom asphaltic layer (4) with a release liner(page-5, para-0028). The substrate is bonded to the polyolefinic sheet (15) using adhesive (13). The sheet (15) can be white in color and have UV-inhibitors such as titanium dioxide (p[age-6, para-00320.

The sheet would inherently exhibit the claimed reflective properties as all components are the same as that of the instant claimed invention.

The adhesive layer (13) can also function as the barrier layer or the primer layer.

The elastomeric sheet 9150 can be reinforced in that it is embossed, etc.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvia in view of Stierli (4442148).

Sylvia, as discussed above, fails to teach the presence of a release liner on the asphalt layer. Stierli discloses a prefabricated asphalt based waterproof membrane (abstract). As shown in figure-1, the asphalt or bituminous layer (1) is bonded to a reflective layer on one surface and a release liner (4) on the opposite surface thereof. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Stierli's teaching of providing a release liner on the asphalt layer in the invention of Sylvia with the motivation to provide for protection to the tacky asphalt surface.

10. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvia in view of Hart (4870796).

Sylvia, as discussed above, fails to teach that the polymeric binder material is acrylic-based or isocyanate-based elastomers. Hart relates to waterproofing membrane having high degree of reflectivity and the membrane material includes urethanes and acrylics, etc. (col. 1, lines 6-8) that are elastomeric (col. 3, lines 55-57). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Hart's teaching of using acrylic or urethane based elastomeric material as the reflective layer on the membrane

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in the invention of Sylvia with the motivation to provide for flexibility to the top reflective layer to prevent cracking.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 10/659,002. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Both the instant application and the application'002 are directed to the same invention of a prefabricated asphalt base waterproof roofing membrane having the same layers in the laminate.

Conclusion

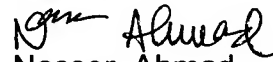
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
March 6, 2005.